

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.: 10/575,653
Filing Date: December 13, 2006
Applicant: Hiroyuki Saimoto
Group Art Unit: 1625
Examiner: Nizal S. Chandrakumar
Title: NOVEL PHENOL DERIVATIVES AND ANTIPANOSOMA
PREVENTIVE/THERAPEUTIC AGENT COMPRISING
THE SAME AS ACTIVE INGREDIENT
Attorney Docket: 5703-000014/US/NP

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

In response to the final rejection mailed December 3, 2008, Applicants have filed a Notice of Appeal, completing the statutory response required. On even date, Applicants have also filed an Amendment after Final addressing the art rejections and a formal matter. Before preparing the Appeal Brief, Applicants respectfully request review of the final rejection based on the following discussion.

Remarks being on page 2 of this paper.

REMARKS

Claims 1-11 stand rejected as obvious in light of Hosokawa et al. (WO 94/04520). The final rejection also contains a rejection under 35 U.S.C § 112 that is dealt with separately in an amendment after Final. Applicants believe that the after final amendment will be entered and at least the § 112 rejection withdrawn. Accordingly, Applicants request review of any rejection remaining after entry of the final amendment. In particular, Applicants traverse the obviousness rejection as discussed below.

THE FURANONE COMPOUNDS OF THE REFERENCE DIFFER GREATLY FROM THE CLAIMED COMPOUNDS IN STRUCTURE

As developed by Applicants in their amendment of October 31, 2008, the compounds of the amended claims differ greatly in structure from the furanone compounds disclosed in the Hosokawa et al. reference. All of the compounds of the Hosokawa et al. reference contain a furanone group at the end of an aliphatic side chain as shown in the abstract of the reference and on page 4 of the non-final rejection mailed May 6, 2008. The furanone compounds of the reference are critical to the hypolipidemic, hypoglycemic and glycation inhibitor properties. See Abstract.

In contrast, the amended claims recite compounds that have aliphatic side chains that do not contain a furanone group. As developed in their October 2008 amendment, Applicants submit that a person skilled in the art would not consider that the claimed compounds could be derived from the Hosokawa et al. reference, not least for the reason that the claimed compounds lack the very feature (the furanone ring) taught as critical in the reference. Based on this teaching of the reference, the person of skill in

the art would not have made the modification necessary to arrive at the claimed compounds.

The claimed compounds are not obvious for the further reason that they exhibit entirely different properties and therapeutic benefits than the compounds of the reference. As stated, the reference compounds are anti-hypoglycemic and anti-hypolipidemic. The claimed compounds, on the other hand, are useful for treating internal parasites such as trypanosoma that cause sleeping sickness.

Applicants respectfully submit that insufficient weight has been given in the rejections to the large structural differences between the reference and claimed compounds, and the widely different properties and therapeutic uses of the respective compounds. In light of those differences, the invention as a whole, which as developed in the After Final amendment filed with even date encompasses both the structural differences and the therapeutic differences, would not have been obvious to a person of skill in the art. For these reasons, Applicants respectfully request that the rejection of the claims as obvious over the Hosokawa et al. reference be withdrawn and the claims passed to a state of allowability.

CONCLUSION

Applicants have completed their response to the final rejection by filing a Notice of Appeal of even date with this Pre-Appeal Brief Request for review. Based on the above discussion, the obviousness rejection is wrongly applied against the amended claims. Further and favorable consideration is solicited. If the Examiner or the review

panel believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (248) 641-1600.

Respectfully submitted,

Dated: June 3, 2009

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